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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------------|---------------------|------------------|
| 10/765,730   | 01/26/2004  | Norbert Miller              | SWR-0124            | 1107             |
| 23413 7590 10/03/2008<br>CANTOR COLBURN, LLP<br>20 Church Street<br>22nd Floor<br>Hartford, CT 06103 |             |                             |                     |                  |
| EXAMINER<br>JOHNS, CHRISTOPHER C   |             |                             |                     |                  |
| ART UNIT<br>3621   |             | PAPER NUMBER                |                     |                  |
| NOTIFICATION DATE<br>10/03/2008  |             | DELIVERY MODE<br>ELECTRONIC |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

# Office Action Summary

**Application No.**

10/765,730

**Applicant(s)**

MILLER ET AL.

**Examiner**

Christopher C. Johns

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 5, 6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 1, 2, 5, 6, and 8 are pending.

### ***Claim Objections***

2. Claims 5 and 6 are objected to because of the following informalities: the claims refer to claim "42", which is a non-existent claim (note that the '4' is not crossed out). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Firstly, the claims refer to a non-existent claim (as noted above) and must be amended to refer to a single parent claim, see 37 CFR §1.75(C).
6. Secondly, the claims make reference to performing operations, that a person having ordinary skill in the art would not understand as to how they could be effected.
  - a. Claim 5 notes that the "visual verification" occurs as a "function of the value". A person having ordinary skill in the art would not understand how a verification (which

appears to be the first time that the document is read) could be based on data that the verification unit has not read yet.

b. Claim 6 notes that the "visual verification" occurs as a "function of authentication certainty". A person having ordinary skill in the art would not understand how a verification could occur as a function of a determination that has not yet been made (note that the "determining a probability" step occurs at least after the "authenticating" step).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 5, 6, and 8 are rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent Application Publication 2001/0006556 ("Graves").

c. feeding document to verification unit (figure 1, reference number 10) by means of input unit (figure 1, reference number 18), wherein verification unit is provided for authenticating the document (Abstract - "system for evaluating currency bills with currency evaluation machines...");

d. authenticating document, wherein authentication document is performed with a combination of at least two different verification methods (figure 1, reference numbers 20, 28; figure 2a, reference numbers 38, 40);

- e. comparing the at least two verification methods with verification specifications (§10 - "a system memory stores first and second types of master characteristic information corresponding to genuine currency bills of assorted denominations and/or series");
- f. determining a probability of authenticity of the document (Abstract - "evaluated bills are identified as either no call bills, suspect documents, or genuine bills");
- g. releasing the document for further processing, comprising accepting document as positively authenticated when the probability meets predetermined criteria (§14 - "if a positive determination is reached in the comparison test, the bill is authenticated as genuine");
- h. rejecting the document as negatively authenticated when the probability does not meet the predetermined criteria (§14 - "if a negative determination is reached in the comparison test...bill under test is suspected to be non-genuine");
- i. recording document as an image and presenting the image to an operator when the document is rejected as negatively authenticated
  - i. §42 - "After identifying no call documents and/or suspect documents, the system...is designed to record identifying characteristics associated with the respective no call or suspect documents...the signal may comprise a voltage level, numerical value, or any suitable response to the occurrence of the no call document. The signal is recorded in system memory...for recall, review and/or printout by an operator".

- ii. The Examiner holds that as image data on a computer (the system is a computer, note microprocessor 12 in figure 1) is inherently represented as data, which is inherently stored as numerical data (as this is how computers inherently function), the claim is anticipated by the reference.
- iii. Additionally, the Examiner finds that the recitation of "image data" is nonfunctional descriptive material, as it is merely a type of data that can be displayed to the operator (see MPEP §2106.01). As such, it carries no patentable weight<sup>1</sup>;
- j. two verification methods are selected from the group comprising size verification, magnetic verification (§5 - "currency discrimination is based on the comparison of sensed optical or magnetic characteristics"), image verification, infrared verification, UV verification (§6 - "UV or visible light..."), and visual verification (§6 - "visible light reflectance");
- k. visual verification method is performed as a function of the value of the document (verification is done to determine value - if the bill is a "no call" or a "suspect document" then it likely has no value, whereas if it is genuine it has the face value of the bill);
- l. visual verification method is performed as a function of authentication certainty (verification is done to determine the authentication certainty - if the bill is a "no call" or a "suspect document" then there is no authenticity, whereas if it is genuine it is authentic);

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<sup>1</sup> MPEP §2106.01: "...“Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data...When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement”

- m. at least two verification stations, each of which performs a different verification process for authentication of the document (figure 1b, reference numbers 200a-200n; ¶44 - "each maintaining an individual record of no call documents, suspect documents and genuine currency...");
- n. computer unit for comparing results of the verification stations with verification specifications of the document (¶45 - "local system controller 204 processes the information compiled from the individual machines to derive an aggregate record...").

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves in view of Official Notice.

- o. As per claims 1, 2, 5, 6, and 8, it is the examiner's primary position that the claims are anticipated because of the above inherent features (i.e. showing data to the operator)<sup>2</sup>. However, if not inherent, then the Examiner takes Official Notice that showing image data of unauthenticated documents was old and well-known in the art because it allows the operator to either report the document (since there is an image, it

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<sup>2</sup> MPEP §2112.III authorizes a rejection under 35 USC §102 as well as 35 USC §103, when the "the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference". While the

can be copied or printed, and reported to the proper authorities), override the determination (in case there is a clear error in processing), or at least to better understand why the document was rejected (in case the document is dirty, damaged, or misaligned). This creates a more powerful system where operators may view exactly what the problem is with a document, in order to ascertain why it would not be authenticated by the system, and/or take further corrective action.

p. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to show operators images of unauthenticated documents, as this would allow them to better understand why a particular document was deemed as counterfeit. A person having ordinary skill in the art would see this as advantageous because it allows for a more reliable system, one that allows operators to better determine why documents are rejected.

11. Examiner notes that Applicant did not challenge the Examiner's citations of Official Notice in the previous Office Action. Therefore, the cited limitations in claim 5 are taken to be admitted prior art due to the failure to challenge the Examiner's assertions. See MPEP §2144.03 (C).

#### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1, 2, 5, 6, and 8 have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously



in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462.

The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner  
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